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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,705	05/18/2006	Joseph Kennedy	089498.0482.US	2929
39905 7590 09/12/2008 ROETZEL AND ANDRESS 222 SOUTH MAIN STREET AKRON, OH 44308				
EXAMINER ASINOVSKY, OLGA				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
09/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,705

**Applicant(s)**

KENNEDY ET AL.

**Examiner**

OLGA ASINOVSKY

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/06/2008;02/21/2006; 02/15/2006.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9, 12-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,852,804. Although the conflicting claims are not identical, they are not patentably distinct from each other because the formulation of a block copolymer in claims of Patent 6,852,804 is readable in the present claimed invention wherein a composition includes a polyisobutylene segment and a polycycloaliphatic diene polymer. The polycycloaliphatic diene polymer is polynorbornadiene, see claims 2 and 5 in Patent 6,852,804, which is the same as polynorbornadiene of the formula "m" in the present claims 1 and 13. To analyze the structural formula, the disclosure of the Patent 6,852,804 at column 6 teaches the same polynorbornadiene (PNBD). Case law holds

that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970). The block copolymer having an aromatic core with two arms extend in the present claims 2 and 5 (formula (X)) is readable in the claim 4 of Patent 6,852,804. The halogen termination is expected because the cationic polymerization is conducting in the presence of halogenated alkanes as solvent. The difference is that claims in Patent 6,852,804 do not claim multiblock copolymer for the present claim 1. Since claims in Patent 6,852,804 disclose analogous process for synthesizing a star block copolymer, it would have been obvious to one of ordinary skill in the art to use a process for producing a star block copolymer in claims of Patent 6,852,804 with a reasonable expectation to introduce additional polycycloolefin segment for producing a multiblock copolymer for the desired application having desired physical property.

3. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,852,804 in view of Minami et al Patent 5,179,171.

All discussions in the paragraph 2 above are adequately set here. Claims of Patent 6,852,804 do not disclose adhesive and coating application for the present claims 9-10 and 17-18.

Minami discloses random copolymer and process for producing said copolymer. A random copolymer comprises polymerized units of ethylene and polymerized units of cycloolefin monomers, column 1, lines 18-20. The random copolymer can be blended with polyisobutylene, column 16, line 33. The random copolymers have excellent transparency, heat resistance, solvent resistance and mechanical properties. The random copolymer can be used as protecting agent for coatings and for hot-melt adhesives, column 15, lines 53-67 and column 16, line 4. It would have been obvious to one of ordinary skill in the art to use a block copolymer in claims of Patent 6,852,804 for coating purposes and for adhesive application by teaching in Minami since both references disclose cycloolefin block segment having properties for coatings and hot-melt adhesive.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. Claims 1-9, 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al U.S. Patent 6,852,804.

The applied reference has a common inventor name with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131. All discussions in the paragraph 2 above are adequately set here.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References have been considered. None discloses a multiblock copolymer of a polyisobutylene polymer segment and a polycycloolefin segment (e.g., norbornadiene) or a star-block copolymer specified in the present claims.
3. Reference Patent 6,350,832 to Bell et al is cited of interest. Bell discloses polymerization of norbornene-type monomers. For imparting elastomeric properties the elastomer such as polyisobutylene can be dissolved in the polycyclic olefin streams, column 50, lines 27-48. There is no formation of a multiblock copolymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLGA ASINOVSKY whose telephone number is (571)272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

Olga Asinovsky  
Examiner  
Art Unit 1796